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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,374	02/23/2005	Kei Etou	7398/84282	5196
42798	7590	03/13/2009	EXAMINER	
FITCH, EVEN, TABIN & FLANNERY			BURNEY, RACHEL L	
P. O. BOX 18415			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20036			1795	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,374	<b>Applicant(s)</b> ETOUE ET AL.
	<b>Examiner</b> Rachel L. Burney	<b>Art Unit</b> 1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 23 December 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1,2 and 6-13 is/are pending in the application.

4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2, 6-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 February 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/06)  
 Paper No(s)/Mail Date 12/19/2008

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 12/19/2008 was filed after the mailing date of the application on 02/23/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Objections***

2. Claims 7 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In applicant's arguments, filed 12/23/2008, applicant argues that "ground and polymerized toners are completely different" (page 5). In view of this argument and numerous references in the instant specification, it is the examiner's understanding that a ground toner and a polymerized toner are mutually exclusive. The structure of claims 1 and 7 would require the toner to be both ground (claim 1) and polymerized (claim 7).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if the toner is a ground toner or a polymerized toner.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 4599289, Suematsu et al.

With respect to claims 1 and 2, Suematsu discloses a toner which comprises a pulverized (ground) core, which is then reacted with a resin to form an encapsulated toner (column 5, lines 16-42), wherein the shell may comprise a urea-formaldehyde resin (column 3, line 54 – column 4, line 8). Suematsu is silent as to the softening temperature and the fusing temperature. The specification of the instant application discloses that the core can be any commercially available toner (see Example 1 {paragraphs 0296-0311}). Because the toner and the coating are substantially similar in the instant application and Suematsu, it would be reasonable to conclude that the covered toner of Suematsu would have substantially similar properties, including those of having a softening temperature between about 40 to about 150°C and a fusing temperature of 145°C or lower.

With respect to claim 6, Suematsu discloses that the shell may be in the range of 0.5-3  $\mu$ m (column 4, lines 9-13).

***Claim Rejections - 35 USC § 103***

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4599289, Suematsu et al. as applied to claim 1 above, and further in view of US PGPub 2002/0160289, Teshima et al. Suematsu discloses the toner of claim 1 as discussed above, but is silent as to the shape. Teshima discloses a toner which may be produced by grinding (PP 0055-0056) which has a circularity of 0.93-0.99 in order to improve the fluidity, cleaning capability, and transferability of the toner (PP 0041). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a toner having a circularity of 0.3-0.99 for the toner of Suematsu to improve the fluidity, cleaning capability, and transferability as taught by Teshima.

***Response to Arguments***

9. Applicant's arguments, see pages 5-7, filed 12/23/2008, with respect to the rejection(s) of claim(s) 1, 2, and 7 over Imai, claim 6 over Imai and Kohri, claim 8 over Imai and Serizawa, and claim 9 over Imai and Nakamura have been fully considered and are persuasive. Therefore, all of the rejections presented in the previous Office Action have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed above.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark F. Huff/  
Supervisory Patent Examiner, Art Unit 1795

RLB